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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,046	12/21/2001	John W. Kosty	47634/GTL/F161	3631

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EXAMINER

MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,046

Applicant(s)

KOSTY ET AL.

Examiner

Barbara J. Musser

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group II in Paper No. 6 is acknowledged.

The traversal is on the ground(s) that both independent claims now require the same materials. This is not found persuasive because the inventions are still distinct since the product can be formed by a different method such as molding the casing and then applying the sealing member to the formed casing.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by the sealing element having a portion that projects away from the casing. It is unclear if this means simply the sealing element extends past the end of the casing continuing in a straight path or if this means the end of the sealing element is directed away from the plane in which the casing resides as shown in Figure 4.

Claim 28 recites the limitation "the case members" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. It is suggested this is intended to be --casing members--.

Claim Objections

4. Claim 27 is objected to because of the following informalities: The word "position" appears in line 4. It is believed this should be --positioned--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21, 22, 24-26, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savoia(U.S. Patent 5,209,502) in view of Skinner, Sr.(U.S. Patent 3,375,571) and Adell(U.S. Patent 4,338,148)

Savoia discloses a seal comprising a layer of PTFE sealing material bonded to a metal casing wherein the end of the sealing material is pointed away from the casing.(Figure 2) The reference is silent as to the method of formation of the seal. Skinner, Sr. teaches a method of forming a seal wherein the PTFE sealing material and metal casing are bonded together and then the combination is shaped to form the

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seal.(Col. 2, ll. 21-37) It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the seal of Savoia by bonding the casing to the sealing material and then shaping them since Skinner, Sr. discloses this is an inexpensive method of forming a seal(Col. 1, ll. 21-23) and particularly since Adell discloses it is known in the bonding arts to bond a metal layer to a plastic film and then shape them.(Col. 1, ll. 51-57; Col. 3, ll. 22-25) While the references do not specifically disclose trimming the seal to the desired shape, trimming an article to a desired shape is well-known and conventional per se in the forming arts.

Regarding claim 22, Skinner, Sr. discloses the seal is a flat sheet prior to forming.(Col. 2, ll. 22)

Regarding claim 24, Savoia discloses the seals is a sealing disk which is oriented with the sealing element facing inwardly.(Figure 4)

Regarding claims 25 and 29, Savoia discloses seals can be formed containing two casings and two sealing members.(Figure 1) One in the art would appreciate that the method of Skinner, Sr. could be used to form a variety of seals such as that shown in Figure 1, with two sealing members adjacent each other.

Regarding claim 26, while Savoia discloses bonding the two sealing members together, one in the art would appreciate that the method of Skinner, Sr. could be used to make a variety of seals such as one wherein the casing members are bonded together. There are a limited number of ways two seals can be joined together- sealing member to sealing member, casing to casing, and sealing member to casing. One in the art would appreciate that a variety of seals other than the specific one shown in

Savoia could be made using this technique to form the seal components as shown in Savoia and would do so depending on the specific seal required.

Regarding claim 31, Skinner, Sr. discloses the sealing element can be bent with the casing, which would place force on it.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savoia, Skinner, Sr., and Adell as applied to claim 21 above, and further in view of Kondo(U.S. Patent 3,649,033).

The references cited above do not disclose the sealing element having a high surface area made from a plurality of features. Kondo discloses a sealing element having a high surface area made from a plurality of features which prevent fluid from passing through the seal.(Abstract; Figure 2) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sealing element of Savoia and Skinner, Sr. have a high surface area made from a plurality of features since this would prevent fluid from passing through the seal region.(Abstract)

8. Claims 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torii et al.(U.S. Patent 5,147,494) in view of Skinner, Sr. and Adell.

Torii et al. discloses a seal wherein the casing of one seal contacts the casing of another. The seals are bonded such that the sealing member of one seal contacts the casing of another.(Figure 2) The reference is silent as to the method of formation of the seal. Skinner, Sr. teaches a method of forming a seal wherein the sealing material and casing are bonded together and then the combination is shaped to form the seal.(Col. 2, ll. 21-37) It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to form the seal of Torii et al. by bonding the casing to the sealing material and then shaping them since Skinner, Sr. discloses this is an inexpensive method of forming a seal(Col. 1, ll. 21-23) and particularly since Adell discloses it is known in the bonding arts to bond a metal layer to a plastic film and then shape them.(Col. 1, ll. 51-57; Col. 3, ll. 22-25)

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is (703)-**305-1352**. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



BJM
May 29, 2003



SAM CHUAN YAO
PRIMARY EXAMINER